

No. 16132

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

JAMES MOON, EDMOND M. WAGNER and PHILIP SUBKOW,
Appellants,

vs.

CABOT SHOPS, INC., and HOWARD SUPPLY COMPANY,
Appellees.

APPELLANTS' PETITION FOR REHEARING.

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APPELLANTS' PETITION FOR REHEARING.

Appellants James Moon, Edmond M. Wagner and Philip Subkow do hereby petition this Honorable Court to reconsider and rehear its decision in the above entitled cause made September 21, 1959.

The grounds for this petition are:

1. That this Court has overlooked the disclosure of the Moon patent, the stipulated facts of the pre-trial order, and the uncontradicted evidence given at the trial, and the admissions of Appellees in open Court, all of which establish that the inventive advance disclosed by the Moon patent, is found in the accused devices, as well as in the form of the device incorporated in the claims as construed by this Court. The "crux of the invention" is not limited to the "straddling" of the cab by the derrick legs if this be the feature that distinguishes the accused device from the patented device.

2. That, because of this error in the facts, the Court has arrived at an erroneous construction of the claims and

has also denied to the patent the scope to which the Doctrine of Equivalents entitles it; and that this decision is, therefore, in conflict with the decisive decisions of the Supreme Court and the earlier decisions of this Court.

3. That the Court erred in applying the rule of File Wrapper Estoppel by restricting the claims to a degree not required by the cited prior art and erred in failing to note that the form of the accused device does not embody the features of the prior art but does embody the features of the patented device.

4. That, accepting the construction of the claims, as announced in this Court's decision, the claims read directly on the accused devices, in that the cab of the accused devices is positioned within the area between the framework which constitutes the rear legs of the derrick, *i.e.*, the legs "straddle" the cab, within the meaning of the phrase as construed by the Court. This point apparently has been overlooked by the Court.

All of these points were discussed in Appellants' briefs on appeal, and none of these are new. We discuss each of these below.

1. The Court Erred in Finding That the Crux of the Patentee's Inventive Advance Is Found in the Form as Claimed in Claim 1.

The Court stated:

"* * * It would seem therefore that in the opinion of the Examiner the straddling of the cab by the derrick legs was the crux of the invention.

"We cannot say that the conclusion of The Examiner in this regard was unwarranted. The Moon structure solved many of the problems posed by the

back-in units. The derrick as combined with the chassis and the cab produced a structure which was at once stable, safe and maneuverable. It was the interaction of the derrick with the chassis and the cab positioned as described in the claims that made for patentability in this case. It was that interaction which produced the desired stability, safety, and maneuverability not previously achieved by any portable derrick unit." (Decision p. 5.)

"As noted above, the invention of the patented structure is the positioning of the derrick so that its legs straddle the cab or driver's position. In order for the derrick legs to straddle the cab the derrick hinge must be positioned above the driver's position." (Decision p. 7.)

"The scope of the invention in this case is set forth clearly in claim one. In accordance with the rule of the *Kemart* case, *supra*, we decline to broaden it." (Decision p. 10.)

We understand the decision of this Court to mean that this Court concludes that the inventive advance described in this patent arises from the form of the invention illustrated in the drawings and that this is the form set forth in Claim 1.

We find difficulty in reconciling such a conclusion with the conclusions reached by the Court in analyzing the inventive advance which is the contribution which Moon made to the portable derrick art.

The Court found this inventive advance resulted in the production of a stable, safe and maneuverable portable derrick which solved the problems of the prior art back-in units. The Court in describing the portable derrick of

the patent did not include as a feature thereof the relative position of the derrick legs and the cab. It characterized the portable derrick as follows:

“The patent in suit involves a portable derrick of the type used for drilling and servicing oil wells. A telescopic derrick is mounted above the driver’s cab at the front end of a truck chassis. An engine is mounted at the rear of the chassis. Winches are positioned between the driver and the engine. A hinge about which the derrick rotates is so positioned at the front of the chassis that when the derrick is transported it lies above the engine and the driver with its bottom to the front of the chassis. Means are provided to rotate the derrick on the hinge so that it may be erected. The derrick is transported in a collapsed position but is extended to working height on erection.” (Decision p. 2.)

and characterized the deficiencies in the prior art which were solved by the patentee as follows:

“First among these was the necessity of having to back the truck into position at the well head. The backing process was often time-consuming and difficult to accomplish. Second, this back-in type of derrick presented certain problems with regard to safety. It had only a small margin of stability. Moon testified that he had seen a back-in unit overturn. In addition, the hinging of the derrick at the rear of the chassis created some danger to the driver in the event the derrick should fall back during or after the erection process. Third, the back-in type, because of its weight and arrangement of components, was illegal for transportation over the highways of many states.” (Decision p. 2.)

The inventive advance which solved these problems, as the evidence shows, is present in the accused device as well as in the patented device. If the Court be right that the form of the device embodied in claim 1 is not the form of the accused device, then it must follow that claim 1 describes only a particular form of the invention. The crux of the invention is not in the particular form embodied in claim 1. It is also embodied in the accused units.

We here make a distinction between the inventive advance as a fact and the form of the inventive advance, which the Court has concluded is defined by the claims of the patent. There simply is no evidence in this case, apart from the Court's construction of what the Examiner said, to support any limitation of the inventive advance to the form illustrated in the drawings. The appellees never urged such a contention. Their position has been that the claims were limited by File Wrapper Estoppel and as so limited they were not infringed. (Brief for Appellees, p. 11.) The uncontradicted facts are:

- (A) That the Patent Nowhere States That the Location of the Legs With Respect to the Cab, as Shown in the Drawings, Is the "Crux of the Invention" as Disclosed in the Patent.

We have discussed this point at page 77 of the Appellants' Opening Brief. The features of the invention, as described in the patent, are, we believe, correctly stated by the Court at page 2 of its Opinion and quoted above, which does not include the entrance of the cab into the space between the legs as any material part of the invention disclosed.

- (B) The Same Properties Which the Court Found to Be the Advance Made Are Found in the Accused Devices, as Well as in the Form of the Device Claimed in Claim 1.

The Court below so found by adopting as Findings of Fact stipulated facts, stated in the pre-trial order. These were item 16 of the pre-trial order and item 55 of the plaintiff's pre-trial Statement of Fact, which were incorporated in the pre-trial order and which were adopted as Findings of Fact. [These Findings of Fact were set forth in Appellants' Opening Brief, item 16 at p. 23 and item 55 at pp. 32-34. See also Record pp. 45-47. See also Record pp. 60 and 61].

The testimony of Mr. Moon and Mr. Woody, Appellees' Chief Engineer, who each made an analysis of the functioning of the accused structures and the patented structure, established that in both the accused structures and patented structure are found the elements which made the drive-in unit, exemplified in these various forms, an inventive advance over the prior art. *This testimony was uncontradicted.* We analyzed this evidence at pages 34 to 46 of the Appellants' Opening Brief.

- (C) That This Inventive Advance Was Found in Both the Structures of the Accused Device and in the Form Illustrated in the Drawings of the Patent Was Admitted by Appellees.

It is stressed in their advertisements set forth at pages 31 to 32 of the Appellants' Opening Brief. The equivalency was admitted in open Court by the Appellees' Counsel, Mr. Kenway, in argument. See the Record, pages 500 to 501, and Appellants' Opening Brief at pages 76 to 77.

We are not here discussing the scope of the claims or the Doctrine of Equivalents. We are concerned here with the nature of the inventive advance irrespective of what the Court may hold to be the portion of the advance included within the claims. The above considerations are advanced to show that the accused form of the drive-in unit embodies the Moon inventive advance as well as does the form described in the claims as they are construed by the Court.

We, therefore, urge this Court to modify its opinion to state that the crux of the Moon invention is not restricted to the form of the device as it is defined in claim 1, as construed by the Court, even if this Court should, contrary to what we urge below, find that all the claims are by their terms restricted to the "straddling" of the cab by the legs of the derrick and that in the accused device the cab is not so "straddled."

2. The Court Erred in Restricting all of the Claims to Be Co-Extensive in Scope With Claim 1.

The Court having found that the inventive advance is exhausted by claim 1, and that the accused device was not of this form, refused to read claims 2 to 5 as being broader than claim 1. (Decision pp. 8 and 10.)

If the Court on reconsideration agrees with us that the inventive advance is present in both the accused device and in the form as stated in claim 1, then we respectfully urge the Court that it should find that the claims of the patent are infringed. We urge that the Doctrine of Equivalents requires that the claims be held infringed by the accused device, which is conceded by the Appellees to be the full equivalent of the device shown in the Patent drawings.

We urge upon this Court that the Doctrine of Equivalents comes into operation after the claims have been construed as to their scope. The Doctrine of Equivalents comes into operation when the inventive advance has been appropriated, but there is some change in the means, manner of operation or result from the invention as claimed. Unless form is of the essence of the invention, a change in the form of the means which embodies the inventive advance and makes no substantial change in the mode of operation or in the result, is an infringement, *even though the claims are limited to a specific form not employed in the accused device*. This, we believe, is the law as set forth in the following decisions, all referred to in the Appellants' Opening Brief at pages 78 and 79 and in the Appellants' Reply Brief, pages 12, 13 and 15 to 17.

Winans v. Denmead, 15 How. (56 U. S.), 330 at pp. 339-340 (Quoted at pp. 15-16 of Appellants' Rep. Br.);

Graver Tank Mfg. Co. v. Linde Air Products Co., 339 U. S. 605, 70 S. Ct. 854 at pp. 855-856; 94 L. Ed. 1097; 85 U. S. P. Q. 328 at p. 330 (Quoted at pp. 17 and 18 of Appellants' Rep. Br.);

Angelus Sanitary Can Mach. Co. v. Wilson et al. (9th C. C. A. 1925), 7 F. 2d 314 at p. 318 (Quoted at pp. 12a-14a of the Appendix to Appellants' Op. Br.);

Cutter Laboratories v. Lyophile-Cryochem Corp. (9th C. C. A. 1949), 179 F. 2d 80 at p. 89 (Quoted at pp. 12 and 13 of Appellants' Rep. Br.);

Saco-Lowell Shops v. Reynolds (4th C. C. A. 1944), 141 F. 2d 587 at pp. 593-594 and cases therein cited (Quoted at pp. 17a-20a of the Appendix to Appellants' Op. Br.);

G. H. Packwood Mfg. Co. v. St. Louis Janitor Supply Co. (8th C. C. A. 1941), 115 F. 2d 958 at pp. 962-963 (Quoted at pp. 15a-17a of the Appendix to Appellants' Op. Br.).

We believe these cases to be controlling.

If the Court agrees with us that the evidence demonstrates that the inventive advance is found also in the accused device and that therefore form is not of the essence of the invention but instead is merely the environment in which the invention is embodied, then *American Seating Co. v. Ideal Seating Co.* (6th C. C. A. 1941), 124 F. 2d 70 cited by the Court at page 7 of the Court's Decision is not apposite.

We submit that, the Doctrine of Equivalents starts where construction of the claims end. Having construed the claims, the question whether the invention as claimed has been appropriated in substance, irrespective of the disguises in which it is exemplified, needs to be answered. We urge that the answer must be that the substance has been appropriated by the shifting of the cab backward from the hinge point to an immaterial degree.

- (A) The Court Erred in Concluding That It Is Bound by a Finding of Fact Made by the Court Below That the Accused Device Is Not Equivalent to the Device of the Claims as Construed by This Honorable Court.

The Court stated:

“The factual finding of the trial court that the accused devices are not equivalent to the patent claims, as so construed, is not to be disturbed unless clearly erroneous. *Graver Mfg. Co. v. Linde Co.*, 339 U. S. 605, 610. We find no clear error in the making of this finding.” (Decision p. 10.)

The only statement by the Trial Court on the issue of equivalency is found in Conclusion of Law 4 which is set forth in the Record at page 90. This Conclusion of Law is not such finding of fact as is referred to in *Graver Mfg. Co. v. Linde Co.*, *supra*, 339 U. S. 605, 610.

It cannot be said that the Trial Court found as a fact that there was any difference in means, manner of operation or result between the accused devices and the patented device. The decision of the Supreme Court referred to by the Court makes clear that the findings of fact referred to related to these factual matters which creates the findings of fact of equivalency or non-equivalency. But whether or not Conclusion of Law 4 is a finding of fact, the evidentiary facts are not in dispute. The conclusion is clearly in error.

The prior art evidence before this Court is summarized at pages 64-65 and discussed in detail at pages 65-75 of Appellants' Opening Brief. None of this prior art shows a drive-in derrick of either the patented form or of the accused device or of any other form. There is no evidence to support the Trial Court's conclusion of law, and the Appellees in their briefs have made no showing in sup-

port of this conclusion. They have abandoned the Court on this point (see Appellants' Rep. Br. p. 5).

The undisputed facts have been stated in point 1 above. *The equivalency between the accused device and the device of the patent is admitted.* The exhibits and records are available to this Court and the Court may itself determine wherein differences, if any, be. In such case the issue of infringement resolves itself into one of law, depending on a comparison between the claimed device and the patented device and if required on the correct application thereto of the Rule of Equivalency.

Kemart Corp. v. Printing Arts Research Labs. (9th C. C. A. 1953), 201 F. 2d 624 at pages 627-628 (Quoted at p. 23a of the Appendix to Appellants' Op. Br.) cited with approval in *Kwikset Locks v. Hillgren* (9th C. C. A. 1954), 210 F. 2d 483 at pages 488-489.

We urge this Court to reconsider the conclusion that there is no equivalency between the accused device and the patented device and find infringement.

3. The Court Erred in Concluding That the Claims Are Restricted by File Wrapper Estoppel to a Form Not Employed by the Accused Device.

We believe the Court is in error in its statement that the claims of the patent were allowed by the Examiner because the claims were restricted by amendment to the so-called "straddling" feature. We call particular attention to pages 91 through 93 of the Appellants' Opening Brief.

(A) The file wrapper shows claims 14 to 17 were not amended to recite that the rear legs and not the front legs straddle the cab. They were cancelled, instead, and claims 19, 20 and 21, now claims 2, 3 and 4 of the patent, were introduced. These claims do not state that

the rear legs and not the front straddle the cab. The word "straddle" in claims 2 to 4 applies to the front legs as well as the rear legs. We believe the record is clear that the applicant rejected the Examiner's requirements, that all of the claims be restricted as in claim 1 and insisted on a broader construction of the invention. *If the front legs in the patented device "straddle" the cab then certainly they do so also in the accused device.*

(B) The applicant Moon specifically refused to accede to the Examiner's request that all the claims be limited to the form of claim 1, urging that his invention was broader in character.

(C) Furthermore, it must be pointed out that claim 5 was presented in the amendment presenting claims 19, 20 and 21, and that it was allowed without amendment.

If, as the Court concludes, notwithstanding the above contentions, the claims were all limited by amendment to recite the form of claim 1, *the Court should note that none of the prior art relied upon by the Examiner in rejecting the claims disclosed a structure which is described by the Court at page 2 of its Opinion to be the structure of the patent.* None of them showed a drive-in unit in which the derrick was so positioned at the front of the chassis so that it might lie above the engine and the driver and the winch, when in retracted position, and be erected at the front of the chassis.

We urge that the rule announced by the Ninth Circuit Court of Appeals and by the Second, and Fifth Circuit should be followed by this Court. Limitations introduced into the claims by amendment to avoid rejection over prior art should be construed to narrow the claims only insofar as it is necessary for them to avoid the prior art relied on by the Examiner. We call attention to *Angelus*

Sanitary Can Mach. Co. v. Wilson et al. (9th C. C. A. 1925), 7 F. 2d 314 at page 318 and referred to at pages 79 and 82 of Appellants' Opening Brief and quoted at pages 12a-14a of the Appendix to Appellants' Opening Brief, and *International Cellucotton Products Co. v. Sterelek Co. Inc.* (2nd C. C. A. 1938), 94 F. 2d 10, quoted at pages 15-16 of the Appendix to Cross-Appellees' Reply Brief, *Hunt Tool Company v. Lawrence* (5th C. C. A. 1957), 242 F. 2d 347 at 354, referred to in this connection at page 97 of Appellants' Opening Brief and quoted at page 13 and 15 of the Appellants' Reply Brief. See also *Farrington v. Haywood* (6th C. C. A. 1929), 35 F. 2d 628 at page 631.

4. The Court Overlooked the Fact That the Form of the Invention as Described by the Claims, as Construed by This Court, Is Embodied in the Accused Device in That the Derrick Legs in the Accused Device Straddle the Cab.

Our next point is that, assuming this Court be correct that the crux of the inventive advance is stated in claim 1, and that it requires that the cab be positioned in the space between the legs of the derrick, we then urge on this Court that the uncontradicted testimony in this case is that the accused devices conform exactly with this definition.

Mr. Moon's analysis of the construction and functions of the accused devices clearly establishes that the framework composed of the outriggers and the truss which supports the hinge carries the loads on the derrick to the ground. *This framework constitutes the rear legs of the derrick. There is one such structure on each side of the cab, and the cab is positioned between them.* (See Appellants' Op. Br. pp. 43 to 45). Mr. Woody, Appellee's

Chief Engineer, gave the same evidence (see Appellants' Op. Br. p. 45). While Appellants have asserted in their Appellants' Brief, p. 9, that claim 2 is not literally infringed (see also Appellee's Reply Brief, pp. 3 and 4), *this testimony was not contradicted or in any way challenged by Appellees, either by testimony at the trial or in their briefs.*

In Appellants' Opening Brief, at pages 51, 58 and 59, we stated that the claims read on the Appellees' structure and that recourse to the Doctrine of Equivalents is unnecessary. At pages 58 to 63 we applied the claims to the accused structure. At pages 60 and 61 of Appellants' Opening Brief we pointed out that the rear leg structure formed of the outriggers and the frame members 23d and 23e [see Ex. 57 in the Appendix to Appellants' Op. Br.], which corresponds to L-6 [see also L-6 of Ex. 95 in the above appendix], "straddled" the driver's position, *i.e.*, that the cab is directly between such structures, which are on each side of the cab. We stated, at page 4 of the Appellants' Reply Brief, "The legs of Appellees' derrick functionally and structurally 'straddle' the cab and driver position in the cab even if the word 'straddle' is to be limited in the sense urged by Appellees."

Thus, we believe it to be true, as is shown by the evidence, that to establish infringement no recourse to the Doctrine of Equivalents is necessary since the claims are valid and read on the accused device, which embodies the inventive advance of the claims. This ends the matter, as was stated in the case of *Graver Tank and Mfg. Co. v. Linde Air Products Co.*, cited *supra*. See 85 U. S. P. Q. 328 at 330:

"In determining whether an accused device or composition infringes a valid patent, resort must be had

in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

We believe this point has been overlooked by the Court, since we find nothing in the Court's decision expressly ruling on this issue. Even if all the other points in our petition are insufficient, we urge that this is enough for the Court to find infringement of the claims.

Conclusions.

We urge this Court that because of the above errors this cause should be reconsidered and that the Trial Court's judgment insofar as it held the patent not to be infringed be reversed and the accused device be held to be infringements of this patent. If this is not the view of the Court we respectfully urge that the decision be clarified to state, what the evidence shows without contradiction, that the inventive advance is embodied in the accused form as well as in the patented form, and that the form of the accused device is the substantial equivalent of the device as described in the patent and as illustrated by the drawings, even though the Court conclude that the claims must be restricted because of the Examiner's action and amendments made, so that they are not infringed.

Respectfully submitted,

PHILIP SUBKOW,

In Propria Persona and Attorney for Appellants,

Certificate.

The undersigned appearing *in propria persona* and as counsel for the Appellants, James Moon and Edmond M. Wagner, certifies that in his judgment the herein petition is well founded and that it is not interposed for delay.

PHILIP SUBKOW,